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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,558	09/22/2003	John H. Sohl III	36507-193188	5541
26694	7590	12/28/2007	EXAMINER	
VENABLE LLP			MOSS, KERI A	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20043-9998			PAPER NUMBER	
			1797	
			MAIL DATE	
			DELIVERY MODE	
			12/28/2007	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/666,558	Applicant(s) SOHL ET AL.	
	Examiner Keri A. Moss	Art Unit 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.
2. Claims 1-7 and 10-34 are pending.

### ***Response to Amendment***

3. The previous rejections under Monson and Adriany have been maintained in light of applicants' amendments and arguments.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1-7, 10-19, 21-22, 26-33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Monson (USP 5,887,491). The rejection is maintained as of record and will not be repeated here.

***Claim Rejections - 35 USC § 103***

5. Claims **20 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Monson, as described supra, in view of Adriany (USP 6,405,135). The rejection under Monson in view of Adriany is maintained as of record and will not be repeated here.

***Response to Arguments***

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive. Applicant argues that Monson does not teach a "software control subsystem...to at least one of configure or reconfigure." As the Examiner discussed in previous office actions, the Examiner finds that Monson has a software system and is capable of performing the actions claimed by applicants, including configuring the flow control subsystem in response to a sensed condition or an operator selection or a preprogrammed condition.

The active language added to the claims, "to", does not give patentable weight to the intended use of the software control subsystem in this device claim. Based on the language of the claims, it is unclear whether applicant's device actually performs the limitations following the "to" or merely is intended to perform those functions. The claim language should make it clear what actions the software performs.

**Conclusion**

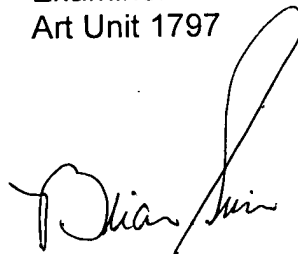
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keri A. Moss whose telephone number is 571-272-8267. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/24/07

Keri A. Moss  
Examiner  
Art Unit 1797

A handwritten signature in black ink, appearing to read "Brian Sines", with a large, stylized loop at the end of the signature.

**BRIAN SINES  
PRIMARY EXAMINER**

### **DETAILED ACTION**

1. Applicant's Amendment filed May 2, 2007 and IDS filed February 7, 2007 are hereby acknowledged.

Claims 1-7 and 10-34 are pending.

### ***Response to Amendment***

2. Rejection of claim 33 under 35 USC 112, second paragraph has been withdrawn in light of applicant's amendments.

Rejection of claims 1-7 and 10-34 under Monson, Robbatt and Griffeth are maintained. Applicant's arguments filed May 2, 2007 have been fully considered but they are not persuasive.

### ***Claim Interpretation***

The claim language of claim 34, including "wherein a membrane interface probe (MIP) sensor is driven into said environmental subsurface and said MIP sensor is in direct contact with soil as well as at least one of ground water, and/or contaminant vapor" is intended use language that does not further modify the structure of the module apparatus. Therefore, this language is not given patentable weight.

***Claim Rejections - 35 USC § 102***

3. Claims 1-7, 10-19, 21-22, 26-33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Monson (USP 5,887,491). The rejection is maintained as of record and will not be repeated here.

Applicant argues that Monson's module does not intelligently adapt on-the-fly to configure or reconfigure a plurality of measurement subsystems in response to sensed conditions. Examiner disagrees. In column 3 lines 10-15, Monson describes a subsystem sensing of GPS location and an intelligent on-the-fly adaptation to configure by positioning the probe. The sensed condition is the GPS location and the on-the-fly adaptation to configure is the positioning of the probe. Furthermore, all of the soil data collection testing and analysis subsystems must be activated once the probe is secured within the soil (columns 3-4). Here, the sensed condition is proper placement of the probe and the configuration is the change from no testing or analysis to initiation of testing and analysis subsystems. A feedback system is described in column 6 lines 36-49. Here, the sensed condition is that the test tubes have been cleaned and are ready for reuse and a signal is sent to the controller. The on-the-fly configuration is the reuse of the test tubes. These examples demonstrate the intelligent on-the-fly adaptation configurations of Monson.

Applicant argues that Monson does not teach or suggest a membrane interface sensor. In Monson, the membrane interface is the window 42c (Fig. 3) or the series of holes 40a (Fig. 3) of the gas chromatography testing assembly.

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Applicant asserts that claims 12, 16, 17, 18 and 19 are patentable over the prior art and are not obvious over the prior art. Examiner believes these claims have been anticipated by Monson and the applicant's arguments refuting the Examiner's anticipatory arguments have not been made. Applicant argues that it would not have been obvious to include a plurality of membrane interfaces due to the longfelt need that the instantly claimed invention allegedly meets. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). MPEP 716.01(c). Also, Monson anticipates these limitations, wherein the plurality of membrane interfaces include either the windows of the probe or the circumferential plurality of holes, wherein the two rows of holes 40a and 40b form a plurality. Second, applicant argues that the use of larger diameter probes would not be obvious as they would increase the cost of the probe. This argument does not address the Examiner's argument that the Monson device meets applicant's size limitations.

### ***Claim Rejections - 35 USC § 103***

4. Claims **20 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Monson, as described supra, in view of Adriany (USP 6,405,135). The rejection under Monson in view of Adriany is maintained as of record and will not be repeated here.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208



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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., driven sensor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Claims **24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Monson, as described supra, in view of Robbatt (USP 6,487,920). The rejection under Monson in view of Robbatt is maintained as of record and will not be repeated here. The only change the Examiner wishes to make to the previous rejection is to correct the citation for part 232 as found in Fig. 2B, not in Figs. 3-5.

Applicant argues that Robbatt teaches away from use of a separable heating element by citing reference to column 6 lines 31-39. This section was not cited by the Examiner and actually references a part other than the one cited by the Examiner. This separate heating element cited by applicant as a teaching away is a part for heating a line 222 that is not within the main chamber of the probe (column 6). The heater cited by the Examiner is part 232, which is located within the probe (column 5). The previous rejection argued it was obvious to make the cartridge heater removable, i.e. replaceable, as opposed to moving the cartridge heater to a different part. Therefore, applicant's argument does not address the previous rejection.

6. Claim **23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Monson, as described supra, in view of Griffeth (USP 491,595). The rejection under Monson in view of Griffeth is maintained as of record and will not be repeated here.

Applicant argues that the instantly claimed probe has met a longfelt need for replaceable malfunctioning probe parts. The applicant has not provided evidence to back up this assertion. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). MPEP 716.01(c). Therefore, applicant has not overcome the rejection.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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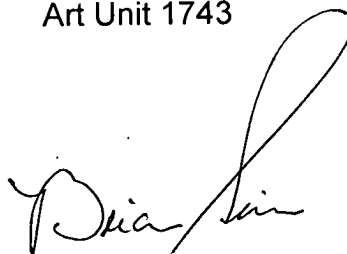
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Keri A. Moss  
Examiner  
Art Unit 1743

KAM 6/10/07

A handwritten signature in black ink, appearing to read "Brian Sines", with a large, stylized loop at the end of the last name.

**BRIAN SINES**  
**PRIMARY EXAMINER**